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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,628	03/29/2004	Kevin Swayne O'Hara	13DV-14043-5/11713 (21635)	3488
31450 7590 08/22/2008 MCNEES WALLACE & NURICK LLC 100 PINE STREET P.O. BOX 1166 HARRISBURG, PA 17108-1166				
EXAMINER SHEEHAN, JOHN P				
ART UNIT 1793		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,628

Applicant(s)

O'HARA ET AL.

Examiner

John P. Sheehan

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2008 and 13 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-19, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15 to 19, 24 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- I. The new claim language, "providing a gas turbine engine component of" (claims 1 and 19, line 3) and "providing an article of" (claim 25, line 3) does not find support in the application as filed. Applicants have cited paragraphs [0019], [0025] and the disclosure as support for this amendment. The Examiner does not agree. Applicants' invention is a method of designing a nickel base superalloy (paragraph [0012] of the specification). There is no disclosure in paragraphs [0019] or [0025] or in the specification that the first step of applicants' process of designing a nickel base superalloy is the step of actually "providing a gas turbine engine component" or "providing an article".

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 15 to 19, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry (US Patent No. 4,388,124).

Henry teaches a nickel base superalloy having a composition that overlaps the nickel base superalloy recited in the instant claims (Abstract and column 4, the Table). Henry teaches a tantalum content of 1 to 5.9 wt. % (Abstract), which encompasses the baseline tantalum content of "more than about 5 weight percent" and the modified tantalum content of at least 1.5 weight percent less than the baseline tantalum content" recited in the instant claims.

The claims and Henry differ in that Henry does not teach the instantly claimed steps of selecting a baseline alloy containing at least 5 wt% Ta and modifying the baseline nickel base superalloy to a Ta content that is at least 1.5 wt% less than the Ta content of the baseline alloy and the sum of Hf, Nb, Ti and W is at least greater than the baseline sum of these elements.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because Henry's Ta proportions overlap both the claimed baseline alloy Ta content and the claimed modified Ta content recited in the instant claims and therefore are considered to establish a prima facie case

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of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, *In re Peterson* 65 USPQ2d 1379 (CAFC 2003). Also, *In re Geisler* 43 USPQ2d 1365 (Fed. Cir. 1997); *In re Woodruff*, 16 USPQ2d 1934 (CCPA 1976); *In re Malagari*, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

It is the Examiner's position that the instantly claimed process is the result of,

"The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", *In re Peterson* 65 USPQ2d 1379 (CAFC 2003). (emphasis added by the Examiner)

In other words, without limiting the aspects of an alloy that can be optimized, *Peterson* plainly states that the normal desire of scientists is to improve known alloys by optimization. By not limiting the aspects of an alloy that can be optimized *Peterson* encompasses the optimization of any aspect of an alloy including the optimization of alloy properties and expense. Further, even in the absence of *Peterson* it is typical procedure to balance the cost of something against its benefits, that is, it is typical to do a cost benefit analysis and make a decision regarding the optimum scenario. The Examiner considers that the claimed process steps of identifying an alloy and selecting an alloy are those steps that would naturally flow in the optimization of Henry's alloys.

Regarding the substitution step recited as the last step of the claimed process, it is the Examiner's position that, in the process of determining "the optimum combination of percentages" it would stand to reason that when the optimum composition is

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determined the original composition is substituted for by the optimum composition as recited in the instant claims.

3. Claims 15 to 19, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of Darolla et al. (Darolla, US Patent No. 6,444,057) or Tamaki et al. (Tamaki, US Patent No. 6,051,083).

Each of the references teaches a single crystal nickel base superalloy for use in making gas turbine parts (Darolla, column 1, lines 54 to 59 and Tamaki, column 1, lines 6 to 15) having a composition that overlaps the instantly claimed alloy (Darolla, column 2, lines 1 to 26 and Tamaki, column 7, lines 37 to 55). Darolla teaches a Ta content of 4 to 12 wt% (column 2, line 8) and Tamaki teaches a Ta content of 2 to 12 wt% (column 7, line 44), which encompass the baseline tantalum content of "more than about 5 weight percent" and the modified tantalum content at least 1.5 weight percent less than the baseline tantalum content" recited in the instant claims.

The claims and the references differ in that the references do not teach the instantly claimed steps of selecting a baseline alloy containing at least 5 wt% Ta and modifying the baseline nickel base superalloy to a Ta content that is at least 1.5 wt% less than the Ta content of the baseline alloy and the sum of Hf, Nb, Ti and W is at least greater than the baseline sum of these elements.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because Darolla's and Tamaki's Ta proportions overlap both the claimed baseline alloy Ta content and the claimed

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modified Ta content recited in the instant claims and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference. In re Peterson 65 USPQ2d 1379 (CAFC 2003). Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

It is the Examiner's position that the instantly claimed process is the result of,

"The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003). (emphasis added by the Examiner)

In other words, without limiting the aspects of an alloy that can be optimized, Peterson plainly states that the normal desire of scientists is to improve known alloys by optimization. By not limiting the aspects of an alloy can be optimized Peterson encompasses the optimization of any aspect of an alloy including the optimization of alloy properties and expense. Further, even in the absence of Peterson it is typical procedure to balance the cost of something against its benefits, that is, it is typical to do a cost benefit analysis and make a decision regarding the optimum scenario. The Examiner considers that the claimed process steps of identifying an alloy and selecting an alloy are those steps that would naturally flow in the optimization of Darolla's or Tamaki's alloys.

Regarding the substitution step recited as the last step of the claimed process, it is the Examiner's position that, in the process of determining "the optimum combination of percentages" it would stand to reason that when the optimum composition is determined the original composition is substituted for by the optimum composition as recited in the instant claims.

Response to Arguments

4. Applicant's arguments filed March 13, 2008 have been fully considered but they are not persuasive.

Applicants argue that none of the references relied on in the prior art rejections teach the substitution of the first nominal composition with the second composition. The Examiner is not persuaded. As set forth in the statement of the rejection,

"The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages". In re Peterson 65 USPQ2d 1379 (CAFC 2003). (emphasis added by the Examiner)

In the process of determining "the optimum combination of percentages" it would stand to reason that when the optimum composition is determined the original composition is substituted for by the optimum composition as recited in the instant claims.

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1700.

/John P. Sheehan/
Primary Examiner, Art Unit 1793

jps